GP 1627

Docket No: CVS-1
Serial No: 09/122,576

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12/5/00

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Person Depositing Paper: Gerard H. Bencen, Esq., Patent Attorney

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	Siev, et al
Serial No.	:	09/122,576
Docket No.	:	CVS-1
Art Unit	:	1627
Examiner	:	Hsu, G
Filed	:	7/24/98
For	:	RESIN DERIVATIZATION METHOD AND USES THEREOF

Assistant Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT; PETITION AND FEE FOR A THREE-MONTH EXTENSION OF TIME

Sir:

This is a timely response to the Restriction Requirement mailed in the captioned application on July 17, 2000. This paper further represents a PETITION that a three-month extension of time be granted for the filing of a response in this case, up to and including November 17, 2000. The appropriate fee for a three-month extension of time is provided herewith.

Claims 32, 37-48, 54-76, 78-101 and 103-116 stand withdrawn from further consideration in this application. Claims 1-27, and 29-31 stand pending in this application, and are subject to a further restriction requirement:

It is stated that claims 1, 6-19 and 30-31, (new Group I), directed to a method for production of a derivatized resin, using a first set of reagents, while claims 2 and 5, is drawn to a method of

preparing products which fall into separate classes and subclasses of aldehydes (New Group II) and ketoamides (New Group III), claims 2-4 and 29, directed to making libraries of derivatized resins using an immobilized aldehyde (New Group IV), or ketoamide (New Group V), claims 20-21 directed to a method for making libraries using a semicarbazone derivatized resin (New Group VI), claims 1, 15-16 and 22, directed to a method for making a semicarbazone derivatized resin of formula (II), (New Group VII), and claims 1, 15-16 and 23-27 drawn to a method for making a semicarbazone derivatized resin of formula (III), (New Group VIII). It is stated that each of these inventions are distinct from each other. Election is hereby made, with traverse, to prosecute in this application the Group I set of claims and subject matter, as it relates to claims 1, 6-19 and 30-31.

It is stated that in response to this Restriction Requirement, the applicant should include an identification of each species in claims 1-27 and 29-31 that is elected consonant with this restriction requirement, and a listing of all claims readable thereon.

The traverse herein is based on the assertion that the subject matter of the various species identified above is closely related as disclosed in the instant specification and claims. Furthermore, it is urged that all grounds for restriction should have been presented in the initial Office Action. It is urged that it is not appropriate for the prosecution in this application to be delayed by repeatedly finer and finer restriction requirements within restriction requirements. In light of these concerns, for example, it might appear that upon election of species and claims consonant with the instant Restriction Requirement, the applicant will be faced with an additional restriction requirement in a subsequent Office Action. Clearly such action would tend to waste the patent term of this applicant, and it is strongly urged that prosecution on the merits in this case should now proceed. This application has now been faced with three Restriction Requirements. In response to the prior Restriction Requirement, the applicant noted:

"Election is hereby made, with traverse, to prosecute Group 1, claims 1-27 and 29-31. The traverse is at least in part based on the following considerations:

It is stated that this new Restriction Requirement is being made "in the interest of compact prosecution", even though the Applicant has already elected Group I, claims 1-27, 29-32, 34-76,

78-101, and 103-106. The Applicant has already elected a species for examination purposes, and such election is hereby affirmed. It is urged that prosecution in this case would be compact if prosecution on the merits could be initiated, without the need to repeatedly revisit the question of generic and species elections. It is noted that there has been a change of Examiners in this case. However, this should not entitle the PTO to re-initiate prosecution. An election has been made on the record, and prosecution should now proceed.

The reasons for considering claims of previously elected Group I, claims 1-27, 29-32, 34-76, 78-101 and 103-106 to come within the same generically patentable concept are set forth on the record in the response filed on January 21, 2000, and that response is incorporated herein by reference, so as to avoid the need to reiterate those arguments here.

In spite of the foregoing remarks, and to ensure that this paper is responsive, it is noted that Examples 2 and 3 set forth prototype reactions for this generic invention. Accordingly, the specifics of the reaction include reaction of a resin defined in Examples 2 and 3, defined as HCAM resin, with a reagent such as that shown in Example 4, namely t-butoxycarbonyl-L-Arg(alloc)2-al. It is urged that all of the elected claims read generically on this specific reaction, and it is respectfully requested that upon confirmation of the patentability of this species that the search and examination should be extended to all other encompassed species."

In order to seek to be responsive to this third Restriction Requirement, it is hereby noted that claims 1, 6-19 and 31, hereby elected for a method for production of a derivatized resin represented by formula I, prepared by a process comprising reacting a starting material (C), with a reactant (D). It is urged that in reactant (D), R4-NH2, the only variable is R4 as clearly defined in the specification. Surely the Examiner is not taking the position that every R4 variant gives rise to a separate invention. With regard to reactant (C), it is likewise noted that the only variables are R1, X, Y and Z. Again, these variables are clearly defined in the specification. Accordingly, it is urged that separate inventions are not comprehended by modifications in these variables. Advancement of prosecution on the merits of these claims is therefore now respectfully requested. It is urged that for purposes of advancement of prosecution on the merits in this case, it would be advisable for the Examiner to initiate a review of the question whether the species of Examples 2 and 3 are

patentable, and to proceed from there to extend the search more generically, if the species of those examples are found to be patentable.

Should there be any question based on this response, it is respectfully requested that the Examiner directly contact the undersigned to discuss resolution of any such question, in the interest of advancing prosecution of this application.

Respectfully submitted,

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